

### **Amendments to the Drawings**

Applicant submits replacement sheets 1-5, corresponding to Figures 1-9, which are now in a form suitable for reproduction. These Figures are appended to this answer.

## Remarks/Arguments

### I. Objections Under 35 U.S.C. §112

#### *A. Objections to Ordering of Discussion of Detailed Description*

Applicant would like to thank the Examiner for clarifying the basis of the previous objection to specification in the teleconference dated 12.18.2006 and its subsequent withdrawal.

### II. Rejections Under 35 U.S.C. §102

Claim 24 was rejected as anticipated by U.S. Patent No. 722,405 issued March 10, 1903 to Ganim. To anticipate a claim, a prior art reference must disclose each and every limitation of that claim, must be enabling, and must describe that claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention. *See Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 1346 (Fed. Cir. 2000). The Ganim reference (Ganim) includes neither a stem that “defin[es] a dry smoke aperture” nor a stem that “terminates in a selectively releasable peripheral down tube dimensioned to substantially penetrate [the] base” as is now required by the currently amended claim 24. Applicant respectfully requests withdrawal of the anticipation rejection.

#### *A. A Stem that Terminates in a Peripheral Down Tube*

Applicant has amended the current application to include a stem that “terminat[es] in a selectively releasable peripheral down tube dimensioned to substantially penetrate [the] base.” As shown by Applicant’s figures 1-4, 8, and 9; the down tube of Applicant’s claim 24 is a distal, removable down tube. In other words, the removable down tube is located and attaches at a low portion of the modular hookah stem. Such a feature is significant because it allows a smaller down tube to be used with hookahs.

The advantages of a peripherally attached down tube are most readily understood by contrast with the down tube disclosed by the Ganim patent. As figures 1 and 2 of the Ganim patent illustrate, the Ganim hookah device includes only an elongate, enclosed down tube. The Ganim down tube includes threading that connects the Ganim down tube

in the extreme interior of the hookah stem. There are at least four disadvantages to such a fastening mechanism: complicated fastening, destructive fastening, inconvenient cleaning of the down tube, and lack of portability.

When fastening and unfastening the down tube of Ganim to his hookah device, a user must fasten that down tube to the extreme upper interior of the hookah stem. As Fig. 1 of Ganim illustrates, a user would need to maneuver the down tube through nearly the entire interior of the stem body to fasten the down tube. Such a feat is further complicated because the connection point is obscured by the stem body. The elongate nature of the Ganim down tube necessitates screwing the down tube into place from a great distance; an act potentially destructive to the threading of the Ganim hookah stem. Slight hand movements would create lateral pressure on any threads adapted to receive the down tube. Additionally, lateral pressure created on one end of the down tube could cause a middle portion of the down tube to deform. Screwing in long objects with threading distant from the point of rotation can be risky depending upon the material from which the object is made.

In addition to the disadvantages posed by the position of the Ganim down tube, the elongate structure of the Ganim down tube poses certain problems. The elongate down tube is the primary dry smoke transport mechanism of the Ganim hookah. Therefore, it is the component in greatest need of frequent cleaning. The narrow nature of hookah down tubes ensures that length is a disadvantage when providing cleaning accessories. As the down tube increases in length, so too must the length of its cleaning implement.

A further problem associated with down tube length is hookah portability. Devices with smaller components are more portable than devices with large components. The elongate down tube of the Ganim hookah has a length practically equivalent to the length of the Ganim's entire hookah. Rather than having a hookah down tube the length of a hookah base and a hookah stem, a more portable hookah down tube would have a length dimensioned for minimal insertion into a hookah stem with a length primarily dimensioned to interact with water within a hookah base. The peripheral down tube of Applicant's claim 24 includes such a down tube.

For at least the above reasons the elongate and embedded interior down tube of the Ganim reference cannot be equated to the peripheral down tube of the stem of Applicant's claim 24, which has not these two traits in combination. Applicant requests that the anticipation rejection of claim 24 be withdrawn.

*B. A Stem Defining a Dry Smoke Aperture*

The Ganim hookah does not include a stem that defines a dry smoke aperture as claimed in Applicant's claim 24. As previously mentioned, the stem of claim 24 includes a peripheral down tube. Because the down tube of claim 24 has a substantially short length, other means must exist to transport dry smoke to the down tube before the down tube can transport dry smoke to the hookah base. Accordingly, the stem interior of Applicant's claim 24 defines the dry smoke aperture: the stem *is* a transport mechanism for dry smoke. The Ganim hookah does not include a stem configured to transport dry smoke, and therefore cannot be cited as an anticipating reference.

As figures 1 and 2 of the Ganim patent illustrate, the dry smoke of the Ganim hookah is ushered through the stem, not by the interior surface of the stem itself, but through the down tube alone. The Ganim stem serves no dry smoke transport function. The Ganim down tube provides a transport mechanism that completely bypasses the interior of the stem because the dry smoke is confined exclusively to the interior of the down tube. Turning now to the Applicant's device of claim 24, the interior surface of the hookah stem forms the aperture by which the dry smoke travels to the hookah base. In Applicant's Fig. 2, for example, the dry smoke aperture can be found in components other than the down tube. For example, (whether separable or not) the plenum 102 of the stem 100 of the Applicant's invention forms the dry smoke aperture from a cavity therein to which the down tube 108 connects to form a more continuous dry smoke aperture; which is significant when contrasted with the Ganim device which has a down tube that forms the sole dry smoke aperture configured to completely bypass the interior of Ganim's hookah stem.

Because the Applicant's device of claim 24 includes a stem that defines a dry smoke aperture, Applicant requests that the anticipation rejection of claim 24 be withdrawn.

### III. Rejections Under 35 U.S.C. § 103

Independent claims 25, 36, 40, and 46 were rejected under 35 U.S.C. §103 as obvious in view of Ganim in combination with Kahler's U.S. Patent No. 3,872,872. Rather than discuss claim 25, however, Applicant relies on the remarks of section II above in establishing absence of anticipation of the currently amended claim 24, and discusses below the nonobviousness of claim 24 (rather than claim 25) with its newly-added limitations from claim 27. In order to establish a *prima facie* case of obviousness, three criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art references must teach or suggest all the claim limitations.

#### A. Claim 24

Applicant asserts that the presently amended claim 24, with its presently amended down tube restrictions previously present in claim 27, is not anticipated by Ganim, and the invention would not be rendered obvious over Ganim in view of Kahler. In discussing the peripheral down tube limitation of claim 27, it was asserted that "it would be obvious to further segment the components...for...releasable attachment because doing so would allow easier cleaning of the Ganim hookah." *Examiner's Action*, page 5. Applicant respectfully disagrees and suggests that a *prima facie* case of obviousness cannot be met because neither the Ganim reference nor the Kahler reference includes the peripheral down tube of claim 24, and there would be no suggestion or motivation to alter the Ganim reference to include such a feature.

#### 1. There Is No Suggestion or Motivation in the References to Modify the Ganim Hookah to Include a Peripheral Down Tube

The newly amended claim 24 now includes a peripheral down tube at the lower portion of the stem. Therefore, it is required that motivation be found to not only alter the dimensions of the Ganim down tube, but to further reconfigure the location of the Ganim down tube attachment point. No such motivation or suggestion to reconfigure and

re-size was mentioned in the Examiner's Action. For at least this reason, any obviousness rejection of Applicant's newly amended claim 24 can not be sustained.

The only suggestion of motivation in the Examiner's amendment relating to altering the Ganim hookah to include a peripheral down tube stated that "further segment[ing] the components...of Ganim...would allow easier cleaning of the Ganim hookah." *Examiner's Action*, page 5. However, further segmenting the Ganim stem would not simplify cleaning of the Ganim hookah. The elongate, embedded down tube (Ganim: element H) of the Ganim hookah allows dry smoke to completely bypass the interior surface of the Ganim stem (Ganim: element D). The unmolested interior of the Ganim stem would not accumulate dry smoke residue, and therefore not require cleaning.

In addition to not finding motivation within the Ganim reference to modify the Ganim hookah to down tube structure as claimed in Applicant's claim 24, a person of ordinary skill in the art seeking to modify the Ganim hookah for purposes of cleaning would be highly discouraged from modifying the Ganim hookah down tube length and location. In cleaning the Ganim hookah, one would unscrew the down tube (element H) from its slot (Ganim: element H1) and clean the interior of the down tube. There would be no reason to clean the interior (Ganim: element I) of the stem (Ganim: element D), because as previously mentioned, the down tube length would have forced the dry smoke to completely bypass the stem interior surface. However, if the Ganim hookah down tube were modified to a terminal, peripheral position, then smoke would enter portions of the down tube recess (Ganim: element I), which would require that a Ganim hookah user now clean two components – the stem and the down tube – instead of merely the down tube.

A person of ordinary skill in the art would further be unable to find motivation in the Kahler reference to alter the Ganim hookah to include a removable, peripheral down tube. The Kahler water pipe consists of a unitary dry smoke delivery stem (Kahler: element 18); it is not segmentable, nor does it include a distinct peripheral dry smoke delivery extension. The Kahler reference discourages alterations that would result in segmentations as he eschews pipes "complicated in their construction." *See Kahler*, col. 1, lines 17-18. He goes on to remind the reader that unitary members are already "quite simple to maintain and to keep clean." *Id.*, col. 3, lines 41-42.

## 2. The Peripheral Down Tube of Claim 24 is Not Present in Ganim or Kahler

The presently amended claim 24 now includes limitations previously found in claim 27, specifically a stem “terminating in a selectively releasable peripheral down tube dimensioned to substantially penetrate [the] base.” This limitation cannot be found in either Ganim or Kahler. As Applicant discusses the absence of this limitation in great detail in Section IIA, *supra*; Applicant will only discuss the elements disclosed Kahler water pipe reference.

The Kahler water pipe includes structure wholly different from a hookah. The nearest analog of a hookah stem and/or down tube, would probably be the dry smoke delivery member (Kahler: element 18). As the Kahler dry smoke member (Kahler: element 18) does not include *any* removable, dry-smoke-conducting portions as Applicant’s claim 24 recites. Instead, the entire dry smoke member (Kahler: element 18) is inserted into the device’s water reservoir (Kahler: element 15). Furthermore, even if Kahler’s dry smoke member was divisible, there is no discussion of peripheral divisibility.

## 3. Conclusion

As neither the Kahler reference, nor the Ganim reference include a stem “terminating in a selectively releasable peripheral down tube dimensioned to substantially penetrate [the] base,” Applicant requests that the examiner consider the presently-amended claim 24, and all claims depending therefrom, as not obvious.

### B. Claim 36

In rejecting Applicant’s independent claim 36 as obvious, the examiner asserts that:

Ganim does not disclose the burner being threaded. Kahler discloses screw threads as being a well known means of attachment. It would have been obvious to one having ordinary skill in the art to substitute the slip on fitting of Ganim with the screw on fitting of Kahler...

Applicant disagrees that such rationale, accuracy aside, is sufficient to support a case of *prima facie* obviousness. The segmented stem (plenum plus intermediate tube) and recited in Applicant’s independent claim 36 cannot be found in the Ganim or Kahler

references, much less with threadings as a fastener. Furthermore, there is no suggestion or motivation within the references to undertake any such modification.

### 1. Neither the Ganim nor Kahler Reference include a Divisible Stem

Applicant's claim 36 includes a stem, but in distinct and removable portions: "a threaded plenum" and "a threaded intermediate tube." Both Kahler and Ganim, although disclosing removable burners, disclose only unitary stems.

As noted in Applicant's par. 003, the stem is the portion of the hookah that conveys smoke from a burner to a fluid-filled base. The stem lies between where tobacco is burned and where the tobacco is submerged into water, which in a hookah would be via a down tube. In Applicant's claim 36, this stem is segmented.

The Kahler reference does include a stem analog (Kahler 18), which is positioned between a burner (Kahler: element 20) and a fluid-filled base (Kahler: element 15). No part of this stem (Kahler: element 18) is segmented into two distinct portions.

The Ganim reference does include a burner ((Kahler: element F), a fluid-filled base (Kahler: element A), and stem (Kahler: element D). Although the stem attaches to a removable down tube, the stem itself includes no segmentation that results in a distinct intermediate tube and a distinct plenum.

As both Kahler and Ganim disclose only unitary stems and Applicant claims a stem comprising a distinct and separable plenum and intermediate tube, Applicant requests that the examiner withdraw his rejection of claim 36.

### 2. There Is No Suggestion or Motivation in the References or General Knowledge Within The Art To Modify The Disclosed References

In rejecting the Applicant's patent claim 36, Examiner does not cite any suggestion or motivation within the art to segment a hookah stem. In a separate rejection of claim 27, Examiner asserted that "it would be obvious to further segment the components...of Ganim using threaded connections for...releasable attachment because



doing so would allow easier cleaning of the Ganim hookah.” *Examiner’s Action*, page 5. However, further segmenting the Ganim tube would not allow easier cleaning because the elongate down tube (Ganim: element H<sup>1</sup>) of the Ganim hookah allows dry smoke to completely bypass the interior of the Ganim stem (Ganim: element D). Dry smoke from the Ganim hookah is funneled to the base in a manner that avoids the entire interior of the Ganim stem; thus, the interior of the Ganim stem would not accumulate dry smoke residue and not require cleaning. Applicant suggests that there would be no motivation to clean a component that does not require cleaning.

In seeking motivation to alter the Ganim hookah stem to create a removable peripheral down tube, a person of ordinary skill in the hookah manufacturing art would not turn to the Kahler water pipe reference to create a segmentable stem for cleaning purposes. Instead of the teaching one of ordinary skill in the art that a segmented stem would assist in cleaning, the Kahler references teaches that a unitary stem is the path towards a cleaner water pipe; he explains in his patent that “it will be apparent that the smoking device [of his FIG. 1] is quite simple to maintain and keep clean.” *See Kahler*, col. 3, lines 40-42. In examining the device of Kahler’s figure 1, it can be seen that the member for delivering dry smoke is a single, unitary dry smoke member, (Kahler: Fig. 1, element 18). Rather than finding motivation, one would only find a discouraging attitude in Kahler towards further segmenting components as he explicitly discourages alterations that would result in pipes “complicated in their construction.” *Id.*, col. 1, lines 17-18.

### 3. Conclusion

Neither Ganim nor Kahler disclose a stem having any segmentation, much less a threaded intermediate tube and threaded plenum. Furthermore, neither reference includes motivation or suggestion to alter their devices to create a bifurcated stem structure.

#### C. Claim 40

Applicant asserts that the presently amended claim 40, with its presently amended stem segmentation and down tube restrictions previously present in claim 42, is not anticipated by Ganim, and the invention would not be rendered obvious over Ganim in

view of Kahler. Applicant's claim 40 now further defines the dry smoke conducting means as "an intermediate tube with a threaded connection; [and] a threaded plenum, releasably attached in gaseous communication with said intermediate tube, having a down tube for releasing dry smoke into said base."

As Applicant's claim 40 now includes a segmented stem, arguments regarding obviousness of segmenting a hookah stem into a distinct intermediate tube and a plenum would be redundant with Applicant's earlier response to the obviousness rejection of claim 36. *See supra* Section III(B).

#### D. Claim 46

Applicant cancels claim 46.

#### IV. Conclusion

Applicant thanks the Examiner for his thorough review of the art and requests that independent claims 24, 36, and 40 – and all claims depending therefrom – be allowed.

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Respectfully Submitted,

A handwritten signature in cursive script, appearing to read "M. Keith Blankenship".

M. Keith Blankenship, Esq.  
Blankenship Law, PLLC  
2815 Hartland Rd. Suite 120  
Falls Church, VA 22043  
Phone: 703-205-0044  
Fax: 703-205-1238  
[www.blankenshiplawpllc.com](http://www.blankenshiplawpllc.com)